

Remarks/Arguments:

Applicants canceled claims 1-20 without prejudice or disclaimer. Applicants reserve the right to reintroduce the subject matter of those claims at a later point in prosecution of this case or of a continuing application. Applicants add new claims 21-26. Those claims are supported by the specification as described in the section below regarding enablement. Claims 21-26 are now pending in this application. Reconsideration and allowance of the application is respectfully requested.

Priority

The Office required correction for the claim of priority because the two PCT applications cited in the initial paragraph lacked application numbers and no relationship was specified. Action at page 4.

As an initial matter, Applicants note that the first paragraph specifies that the instant application is a continuation-in part of the PCT applications. However, without acquiescence on that point, Applicants have removed the priority claims to those applications. The instant application now claims priority only to U.S. Application No. 10/388,578 and U.S. Application No. 10/389,431. That priority claim was present in the first sentence of the application as-filed and was also recognized in the first Filing Receipt issued by the Office. Thus, Applicants contend that the priority claim is correctly stated.

Claim Objections

The Office objected to claim 18 because of a typographical error. Action at page 4. Claim 18 has been canceled, so this objection is now moot.

Double Patenting

The Office provisionally rejected claims 1-7, 10-12, and 14 on the grounds of nonstatutory obviousness-type double patenting as allegedly being unpatentable over claims 1, 5, 6, 11, 12, 47, and 48 of copending U.S. Application No. 10/388,578. Without acquiescence in the rejection or the arguments presented in support of that rejection, Applicants note that the claims of the '578 application have very recently been amended. The new claims specifically exclude podocalyxin-like protein ("PODXL"), while the new claims of the instant application are now specifically limited to use of PODXL. Thus, applicants assert that this issue has been obviated.

Rejections under 35 U.S.C. §112, second paragraph

The Office rejected claims 3, 4, and 7 under 35 U.S.C. §112, second paragraph as allegedly being indefinite. Action at page 6. The Office argued that certain terms in those claims are vague. *Id.*

Applicants disagree with the Office. However, without acquiescence in the rejections or the arguments voiced in support thereof, Applicants have canceled claims 3, 4, and 7. The new claims do not contain the objected-to terms. Thus, this rejection is now moot.

The Office rejected claims 1-7, 10-12, 14, and 17-20 as allegedly being incomplete for omitting essential steps. Action at page 7. Applicants disagree with the Office. However, without acquiescence in the rejections or the arguments voiced in support thereof, Applicants have canceled claims 1-7, 10-12, 14, and 17-20. Applicants assert that the new claims are complete. Therefore, Applicants respectfully request reconsideration and withdrawal of this rejection.

Rejections under 35 U.S.C. §112, first paragraph (enablement)

The Office rejected claims 1-7, 10-12, 14, and 17-20 under 35 U.S.C. §112, first paragraph as alleged not being enabled by the specification. Action at page 7. The Office argued that “[n]one of the claims contain any recitation about whether the plurality of marker genes is to be highly expressed, moderately expressed or not expressed at all and there is no correlation between the expression pattern of protein via antibody assay and the extent of differentiation or assessing any culture.” *Id.* at page 11.

Applicants traverse the rejection and disagree with the arguments of the Office. However, without acquiescence and to facilitate prosecution, Applicants have canceled all of the previous claims and have added new claims 21-26. The new claims are directed to using relative measurements of a specific marker (PODXL) in a population of hES cells to determine whether that population is differentiating. Those claims are supported in the specification, *e.g.*, at page 3, lines 14-17; at page 9, lines 25-28; at page 10, lines 22-36; and in Examples 4, 5 and 8 (and corresponding figures). Thus, Applicants respectfully request reconsideration and withdrawal of the enablement rejections.

Rejections under 35 U.S.C. §102

The Office rejected claims 1, 3, 4, 6, 7, 10, and 12 under 35 U.S.C. §102 as allegedly being anticipated by Pera et al. (“Pera”). Action at page 12. The Office’s rejection was based on Pera’s alleged disclosure of detecting two or more markers preferentially expressed in undifferentiated hES cells and one or more markers preferentially expressed after differentiation. *Id.*

Without acquiescence in the rejections, Applicants note that the claims as-amended in this paper now are limited to the use of a specific marker (PODXL). As there has been no assertion that Pera teaches use of the PODXL marker, Applicants respectfully request reconsideration and withdrawal of the rejection.

Rejections under 35 U.S.C. §103

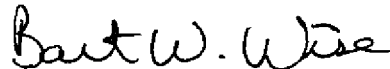
The Office rejected claims 1, 14, and 17-20 under 35 U.S.C. §103 as allegedly being obvious over Pera. Action at page 14.

Again, without acquiescence in the rejections, Applicants note that the claims as-amended in this paper now are limited to the use of a specific marker (PODXL). As there has been no assertion that Pera teaches use of the PODXL marker or makes use of that marker obvious, Applicants respectfully request reconsideration and withdrawal of the rejection.

Fees Due

Should the Patent Office determine that an extension of time or any other relief is required for further consideration of this application, applicant hereby petitions for such relief, and authorizes the Commissioner to charge the cost of such petitions and other fees due in connection with the filing of these papers to Deposit Account No. 07-1139, referencing the docket number indicated above.

Respectfully submitted,



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